



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/549,445	04/14/2000	Becki Speakman	70015060.02	8917

7590 01/27/2003
Jennifer H Hammond
Sonnenschein Nath & Rosenthal
4520 Main Street
Suite 1100
Kansas City, MO 64111

EXAMINER

MOHAMEDULLA, SALEHA R

ART UNIT PAPER NUMBER

1756

DATE MAILED: 01/27/2003 //

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/549,445

Applicant(s)

SPEAKMAN, BECKI

Examiner

Saleha R. Mohamedulla

Art Unit

1756

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-10 are pending. Claim 10 is withdrawn from consideration as being drawn to a non-elected invention. The objections to the drawings are withdrawn in view of the submission of the substitute drawings.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

3. Claims 1 and 6 recite that the “image is to be transferred regardless of the length of such working surface such that the apparatus does not have to be repeatedly applied....” The limitation “regardless of the length of such working surface” is new matter as it is not supported by the original disclosure. The original disclosure does not disclose that the image is transferred regardless of the length of the working surface. This feature is also not inherent or obvious in the original disclosure. The Background and Summary of the Invention discloses large surfaces, such as ceilings or walls. In addition, page 8 discloses that the apparatus is packaged into rolls of variable lengths and widths; therefore, length of the working surface is not irrelevant. The limitation suggests the apparatus can be continuously applied to a working surface with infinite

Art Unit: 1756

length. However, the disclosure does not disclose that the image can be non-repeatedly transferred regardless of the length of the working surface. Claims 2-5 and 7-9 are rejected as being dependent on claims 1 and 6. Correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3-6, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by US# 5,722,120 to Bindschatel et al.

Bindschatel teaches a pre-stamped adherent cover for door hinges. The adherent on the perimeter of an inner surface holds the cover in position while the door is being coated (col. 3, lines 23-25). Therefore, Bindschatel teaches a mask with an adhesive disposed on an inner surface. After the coating has dried, the cover can be peeled off easily and will leave no residue (col. 3, lines 25-30). Therefore, Bindschatel teaches that the backing is removably affixed to the mask at the inner surface and that the mask is adapted to be removably attached to the working surface at the inner surface. In one embodiment, the cover would be provided on a roll, as shown in Figure 3. Therefore, the mask is formed from a unitary and continuous substrate. The adherent cover can be peeled off the backing material 10 and applied to a door hinge quickly and easily (col. 3, lines 30-40). The roll would contain six hundred adherent covers, enough for one hundred doors. Therefore, Bindschatel teaches a plurality of designs formed in the mask.

Art Unit: 1756

Because there are enough covers for one hundred doors, an entire door can be covered without having to remove the masking apparatus. Therefore, Bindschatel teaches that the mask is configured to be selectively dispensable to continuously cover the entire portion of the working surface (door) where the image is to be transferred such that the apparatus does not have to be repeatedly applied after each use to achieve the image transfer along the working surface. The mask is applied in a longitudinal direction on the door (Figures 1 and 2). Because the cover can remain or be peeled off easily and will leave no residue (col. 3, lines 25-30), the mask is affixedly or removably adhered. The length of the working surface does not affect the image transfer. For example, in one roll, there are enough covers for 100 doors, therefore, Bindschatel teaches application to a working surface that is at least 100 times the length of one door without repeated application. Therefore, Bindschatel teaches non-repeat application along a working surface of virtually any length. Figure 3 shows that the apparatus is a roll and that the designs repeat along a portion of the mask. Because there are six hundred designs, the designs repeat. The designs are precut designs, intended to be spray coated (col. 3, lines 20-30). Therefore, the covers form a positive image. The designs are formed in the interior portion of the mask, as shown in Figure 3.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 1756

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over US# 5,460,087 to Ogorzalek.

Ogorzalek teaches a stencil template fabricated from a closed cell foam with a stiff backing. The template has one smooth surface and a contact surface with a temporary stick mastic (col. 1, lines 55-60). The contact surface is allowed to adapt to a textured surface while the mastic provides a sealing that prevents paint from migrating under the template when applied to a surface (col. 1, lines 60-64). The mastic that forms the contact surface will repeatedly adhere to a structural surface to which paint is to be applied (col. 2, lines 23-25). Figure 4 shows the stencil. The stencil template 14 is fabricated from a closed cell foam material with a smooth top surface 50, a bottom contact surface 52 coated with an adhesive for repeatedly adhering the template to a wall surface 48 of a structure 36 as shown in Figure 5 (col. 3, lines 26-33). Claim 1 of Ogorzalek recites that the template has cut-outs through which paint is applied to a surface to which the template is adhered. Figures 1, 2 and 5 show various designs made by the cut-outs. Ogorzalek also teaches that a protective, peel-off paper may be applied to the removable-type adhesive side of the stencil (col. 4, lines 27-31). Therefore, Ogorzalek teaches a mask formed from a continuous and unitary substrate (stencil template) having an outer surface (smooth surface) and an inner surface (contact surface). The inner surface has an adhesive disposed thereon (mastic) and a backing removably affixed to the mask at the inner surface (protective, peel-off paper). Therefore, the mask may be affixedly or removably adhered to the surface. Ogorzalek also teaches a plurality of designs formed in the mask by the cut-outs. Ogorzalek teaches that the templates have die-cut and feature designs that can be repeated by repeatedly

Art Unit: 1756

applying and moving the template along the length of the intended ornamentation (Figure 5; col. 2, lines 4-9). Therefore, Ogorzalek teaches that the template can be applied in longitudinal, as well as other, directions. Also, Ogorzalek teaches that the template is adapted to be removably attached to a surface at the inner surface (contact surface). Because the template can be repeatedly applied and moved, the template is configured to be selectively dispensable to continuously cover a portion of the surface. As shown in Figure 1, stencil 14 has a plurality of designs formed within an interior portion of the mask. These designs are cut-out portions, therefore, when paint is applied a positive image is formed.

Ogorzalek does not teach that the apparatus is selectively dispensable to continuously cover the entire portion of the working surface such that the apparatus does not have to be repeatedly applied after each use to achieve image transfer along the working surface. Ogorzalek teaches, for instance in Figure 5, that the stencil template is repeatedly applied to form a border along a window. However, "working surface" as recited in claim 1 can be interpreted to be only a portion of a particular surface, i.e., one of ordinary skill in the art would use the stencil to pattern a surface that may be the length of the stencil, for example, a small portion to accent the window design. Therefore, the length of the working surface does not matter and the image can be transferred regardless of the length of the working surface. One of ordinary skill in the art would realize that if the working surface were the length of the stencil that the stencil does not have to be repeatedly applied after each use to achieve image transfer along the working surface.

Art Unit: 1756

6. Claims 2 and 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over US# 5,460,087 to Ogorzalek as applied to claim 1 above, and further in view of US# 6,312,872 to Murphy et al.

Ogorzalek teaches or suggests the limitations discussed above in paragraph 5, but does not teach or suggest that a plurality of designs repeat along a portion of the mask, or that designs are formed along an outer perimeter of the mask. Ogorzalek also does not teach that the apparatus is a roll. Murphy teaches a relief image printing plate. Murphy teaches preparing composite printing elements without the need for individual registration of relief image elements and without the need for compensating for elongation due to cylindrical mounting (col. 2, lines 20-25). In one embodiment, Murphy teaches that the printing plate may be cylindrical as shown in Figure 6 (col. 3, line 65 – col. 4, line 10). Therefore, Murphy teaches that the printing plate may be a roll. Because Murphy teaches that the printing element comprises relief elements, Murphy teaches that a negative image will be transferred to a surface. Figures 9 and 14 show exemplary designs on the printing plate. These designs are relief elements. Figure 14 shows a repeating pattern on the left and right sides of the cylinder. Figure 9 shows a repeating pattern of circles. Therefore, Murphy teaches that a plurality of designs repeat along a portion of the mask. Murphy does not specifically teach forming designs along an outer perimeter, however, one of ordinary skill in the art would realize that Murphy envisions embodiments where designs are placed in the outer perimeter because Murphy teaches that individual registration of the designs or elements is not needed when making the plate (col. 2, lines 20-25). Therefore, the plate may comprise designs placed in the outer perimeter.

Art Unit: 1756

The references are analogous art as they are drawn to transferring images by applying masks to a surface; the printing plate of Murphy is used to print a variety of substrate (col. 1, lines 15-20) and the stencil of Ogorzalek is used to print ornamental structures (col. 1, lines 50-55). It would have been obvious to one of ordinary skill in the art to use the pattern and cylinder of Murphy with the mask of Ogorzalek as Murphy teaches that the printing element can be of various shapes, such as a sheet or a cylinder (col. 3, lines 60-67). Because Murphy teaches the shape of the printing element is a design choice, one of ordinary skill in the art would expect that the printing element of Ogorzalek, the stencil, could be made into different shapes.

7. Claims 2 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over US# 5,722,120 to Bindschatel et al. in view of US# 6,312,872 to Murphy et al.

Bindschatel teaches the limitation discussed above in paragraph 3. Bindschatel does not teach that the designs are formed along an outer perimeter of the mask and transfer a negative image. Murphy teaches a relief image printing plate. Murphy teaches preparing composite printing elements without the need for individual registration of relief image elements and without the need for compensating for elongation due to cylindrical mounting (col. 2, lines 20-25). In one embodiment, Murphy teaches that the printing plate may be a roll as shown in Figure 6 (col. 3, line 65 – col. 4, line 10). Because Murphy teaches that the printing element comprises relief elements, Murphy teaches that a negative image will be transferred to a surface. Figures 9 and 14 show exemplary designs on the printing plate. These designs are relief elements. Murphy does not specifically teach forming designs along an outer perimeter, however, one of ordinary skill in the art would realize that Murphy envisions embodiments where designs are

Art Unit: 1756

placed in the outer perimeter because Murphy teaches that individual registration of the designs or elements is not needed when making the plate (col. 2, lines 20-25). Therefore, the plate may comprise designs placed in the outer perimeter.

The references are analogous art as they are drawn to transferring images by applying masks to a surface; the printing plate of Murphy is used to print a variety of substrate (col. 1, lines 15-20) and the cover of Bindschatel is used to print doors. It would have been obvious to one of ordinary skill in the art to use the relief elements of Murphy with the mask of Bindschatel as Murphy teaches that the relief elements are used to print a variety of surfaces (col. 1, lines 15-20). One of ordinary skill in the art would use negative image relief elements instead of positive image elements as both elements can be used to imprint a substrate.

Response to Arguments

8. Applicant argues that the references do not teach a mask formed from a unitary and continuous substrate material wherein the mask is adapted to be selectively dispensed and removably adhered in a general longitudinal direction along a working surface of virtually any length. Bindschatel teaches a unitary and continuous substrate as Bindschatel teaches a roll. Ogorzalek teaches a unitary and continuous substrate as Ogorzalek teaches a stencil. Both can be picked up without falling apart. Therefore, both masks are continuous and unitary. Bindschatel and Ogorzalek also teach application in longitudinal, as well as other, directions. The masks are removably adhered and can be applied to a working surface of virtually any length, as described above. Applicant argues that Bindschatel and Ogorzalek are devices that are repositioned in order to apply an image along the length of a working surface. However,

Art Unit: 1756

Bindschatel teaches that the mask is not repositioned in order to apply the image to the working surface. The door hinge cover is applied to the door. Because the roll is at least long enough for 100 doors, no reapplication is needed to cover one door. That is, one hundred doors can be covered without having to reposition the stencil. In addition, Ogorzalek suggests that the mask need not be repositioned when “working surface” is interpreted to mean only a portion of a particular surface. As described above, one of ordinary skill in the art may use the stencil to pattern a surface that may be the length of the stencil or less. Therefore, Applicant’s arguments are not persuasive. Applicant also argues that Murphy does not teach a mask removably adhered to an entire portion of the working surface along the length of the working surface. Murphy was not relied upon to teach these features; Ogorzalek and Bindschatel were relied upon to teach these features. However, Murphy does teach that the mask is removably adhered because the masking apparatus is a cylinder that rolls along the working surface as it imprints the working surface. Because the cylinder rolls, the mask is removably adhered. Therefore, Applicant’s arguments are not persuasive.

Action is Final

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 1756

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Saleha Mohamedulla whose telephone number is (703) 308-1260. The Examiner can normally be reached Monday-Friday, from 8:00 AM to 4:30 PM. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mark Huff, can be reached on (703) 308-2464. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310. The After Final fax phone number is (703) 872-9311. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

srm 

January 21, 2003



**MARK F. HUFF
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700**